REMARKS

An Office Action was mailed in the above-captioned application on November 19, 2003. In such Office Action claims 29-60 were pending. Claims 29-60 were finally rejected. A Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences was filed on May 16, 2003. This Amendment and Remarks document responds to the rejections in the Office action of November 19, 2003, and is being submitted as the required submission in connection with a Request for Continued Examination.

The Rejection under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 29-36, 8-13, 15-20, 22-27 and 29 under 35 U.S.C. § 102(e) as being unpatentable over the patent to Gold, et al., U.S. Patent No. 6,242,246. The Court of Appeals for the Federal Circuit has stated that anticipation requires the presence in a single prior art reference of each and every element of the claimed invention. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984); *Alco Standard Corp. v. Tennessee Valley Auth.*, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991) (citations omitted).

Although the Examiner indicated that Claims 29-36, 8-13, 15-20, 22-27 and 29 have been rejected, Applicant notes that Claims 1-29 have been cancelled. Also, the rejection discusses Claims 29-34, 36-41, 45-48, 50, and 52-59. The rejection of Claim 35 has not been discussed. Also, in the last sentence of the last paragraph of the rejection, the claim number has been left out. Applicant responds below only to the rejections of Claims 29-34, 36-41, 45-48, 50, and 52-59. Clarification of the rejection is requested.

Claims 29 and 45 have been amended to specify that the detecting comprises detecting by flow cytometry. As Gold, et al., neither teaches nor suggests detecting with flow cytometry, Gold, et al., can not anticipate claims 29, 45, or any claim dependent therefrom. Reconsideration is respectfully requested.

The Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected a number of claims under 35 U.S.C. § 103(a). The Examiner bears the burden of establishing a prima facie case of obviousness (Section 103). In determining obviousness, one must focus on Applicant's invention as a whole. *Symbol Technologies Inc. v. Opticon Inc.*, 19 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1991). The primary inquiry is:

> whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success . . . . Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure.

In re Dow Chemical, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

A. The Rejection of Claims 29-37, 45-52, and 54-60. The Examiner has rejected 29-37, 45-52, and 54-60 as being unpatentable over WO 96/41019 in view of Gold, et al., U.S. Patent No. 6,242,246. Applicant notes that although the Examiner indicates that the rejection refers to Claims 29-37, 45-52, and 54-60, the discussion refers instead to Claims 29-38, 42, 43, 45, 51, 54, and 58-60. Applicant responds below only to the rejections of Claims 29-38, 42, 43, 45, 51, 54, and 58-60. Clarification of the rejection is requested.

Claims 35 and 51 have been cancelled.

The Examiner asserts that the invention of Claims 29, 33, 34, 45 and 60 is disclosed in WO 96/41019 but differs in that the reference does not disclose the limitation wherein two or more target compounds are detected. The Examiner further asserts that multiplex assays were routinely practices in the art as exemplified with nucleic acid ligands by the biochip of Gold, et al. and that the skilled practitioner in the art would have been motivated to detect two or more target compounds in the reference assay for the obvious benefit of obtaining additional information in the expanded assay.

Applicant respectfully traverses this rejection. Claims 29 and 45 have been amended to specify that the detecting comprises detecting by flow cytometry. Gold, et al., neither teaches nor suggests detecting with flow cytometry. While Gold, et al., may teach certain kinds of multiplexing, this multiplexing is limited to techniques which can be performed on a biochip-type solid support, and does not include flow cytometry applications. WO 96/41019 neither teaches nor suggests the use of flow cytometry to detect two or more target compounds. One skilled in the art would not look to Gold, et al. for methods to detect two or more target

compounds using flow cytometry, as the assays in Gold, et al. are not flow cytometry assays, and Gold, et al. neither teaches nor suggests flow cytometry assays.

B. The Rejection of Claims 29-31, 36, 38, 42, 43, 45-48, 52, 54, 58 and 59. The Examiner has rejected Claims 29-31, 36, 38, 42, 43, 45-48, 52, 54, 58 and 59 as being unpatentable over WO 96/40991 in view of Gold, et al, U.S. Patent No. 6,242,246. Applicant notes that although the Examiner indicates that the rejection refers to Claims 29-31, 36, 38, 42, 43, 45-48, 52, 54, 58 and 59, the discussion refers instead to Claims 29-32, 38, 42-48, 54, 58, and 59. The rejection also refers to Claims 6 and 20, which have been cancelled. Applicant responds below only to the rejections of Claims 29-32, 38, 42-48, 51, 54, 58 and 59. Clarification of the rejection is requested.

The Examiner asserts that the invention of Claims 29, 38, 45, and 54 is disclosed in WO 96/410991 but differs in that the reference does not disclose the limitation wherein two or more target compounds are detected. The Examiner further asserts that multiplex assays were routinely practices in the art as exemplified with nucleic acid ligands by the biochip of Gold, et al. and that the skilled practitioner in the art would have been motivated to detect two or more target compounds in the reference assay for the obvious benefit of obtaining additional information in the expanded assay.

Applicant respectfully traverses this rejection. Claims 29 and 45 have been amended to specify that the detecting comprises detecting by flow cytometry. Gold, et al., neither teaches nor suggests detecting with flow cytometry. While Gold, et al., may teach certain kinds of multiplexing, this multiplexing is limited to techniques which can be performed on a biochip-type solid support, and does not include flow cytometry applications. Similarly, WO 96/410991 neither teaches nor suggests the use of flow cytometry to detect two or more target compounds. One skilled in the art would not look to Gold, et al. or WO 96/410991 for methods to detect two or more target compounds using flow cytometry, as the assays described in Gold, et al. and WO 96/410991 are not flow cytometry assays, and the references neither teach nor suggests flow cytometry assays.

In summary, independent claims 29 and 45 have been amended. Applicant respectfully submits that neither the combination of WO 96/41019 and Gold, et al. nor the combination of WO 96/410991 Gold, et al. obviates claims 29 and 45 as amended, nor any claim dependent therefrom. Reconsideration is respectfully requested.

Closing Remarks

Applicant believes that the pending claims are in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

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